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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,770	04/27/2005	Jordi Tormo I Blasco	5000-0123PUS1	2378

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EXAMINER
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PAK, JOHN D

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/532,770	<b>Applicant(s)</b> BLASCO ET AL.	
	<b>Examiner</b> JOHN PAK	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/05, 7/05, 11/05</u> | 6) <input type="checkbox"/> Other: ____.  |

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Claims 1-10 are pending in this application.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 provides for the use of compounds I and II, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 3 appears to contain typographical errors. Presently, the substitution on the pyridine ring represents a line/stick, which means CH<sub>3</sub>. However, this is confusing because the specification shows the compound of II-5 to have a chlorine substitution on the pyridine ring. Clarification is required for both line/stick representations, the one on the pyridine ring and one on the phenyl ring. For the purpose of examination on the merits hereinbelow, it will be assumed herein that claim 3 is directed to compound II-5, as defined by applicant in the specification (i.e. the lines/sticks coming off the rings are intended to represent Cl).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of WO 98/46607 and Eicken et al. (US 5,589,493) in view of the acknowledged prior art.

WO 98/46607 discloses the fungicidal activity of applicant's triazolopyrimidine of formula I. See page 3, lines 5-15; Example 2 on page 20. The compound is disclosed to have enhanced systemic activity and enhanced toxicity to fungi (page 7, lines 8-11). Various solid and liquid formulations are disclosed (pages 13-17). Combined use,

including synergistic effect/use, with myriad other fungicides is disclosed (page 17, line 7 to page 19, line 2; see in particular page 17, lines 12-13). Application to soil, seeds or directly onto plants is disclosed (page 19, lines 2-19). Protection of crops such as cereals, solanaceous crops, vegetables, legumes, apples, vines against phytotoxic fungi is disclosed (paragraph bridging pages 11-12). 0.5-95 wt% formulations are disclosed (page 12, lines 14-15). 0.01-10 kg/ha application rate is disclosed (page 15, lines 10-12).

Eicken et al. disclose the fungicidal activity of applicant's amide compounds of formula II. See Eicken's claims 2-13 and 15; column 32, line 46. Eicken's claim 12 is specifically directed to applicant's compound of formula II-5 (using the more accurate specification definition of II-5). Various solid and liquid formulations are disclosed (column 32, line 47 to column 33, line 60). The amide compounds are disclosed to be "extremely effective on a broad spectrum of phytopathogenic fungi" (column 34, line 56 to column 35, line 5). Application to seeds and protection of various crops are disclosed (id.). 0.1-95 wt% formulations are disclosed (column 35, lines 9-10). Application rate of 0.02-3 kg/ha is disclosed (column 35, lines 12). Combined use with other fungicides "frequently results in greater fungicidal action spectrum" (column 35, lines 20-22). Various other co-fungicides are disclosed (column 35, line 26 to column 37, line 12).

Applicant acknowledges in the specification that both formula I and formula II compounds are known for their fungicidal properties, and both compound types have been combined with other active compounds (specification pages 1-2).

Although the cited prior art does not expressly disclose the specific combination of formula I + formula II fungicides, their combination as claimed by applicant would have been fairly suggested. First, both formula I and formula II compounds are known fungicides, known to protect valuable crop plants from pathogenic fungi. Second, both formula I and formula II fungicides are known to be useful together in combination with other fungicides, resulting in at least increased efficacy or spectrum. Third, one having ordinary skill in the art would have been motivated to combine two such excellent fungicides in order to obtain the benefits of both fungicides. Fourth, both fungicides have similar formulation concentration ranges and comparable application rates, and one having ordinary skill in the art would have been motivated to adjust and optimize the concentration and application rates of the two component fungicides to arrive at the mixture concentration and mixture application rates, based on the individual concentration and application rates taught by the prior art. Since formula I can be formulated as a 0.5-95 wt% formulation and formula II can be formulated as a 0.1-95 wt% formulation, their combination in the ratio claimed by applicant in instant claim 4 would have been obvious.

Therefore, the claimed invention, as a whole, would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention and the claimed invention as a whole have been fairly disclosed or suggested by the teachings of the cited references.

In this regard, applicant's specification data has been reviewed for evidence of nonobviousness, but it must be noted that the data there falls woefully short of being commensurate in scope with that of the claimed subject matter. Only I + II-5 was tested, and even for that combination only with respect to two crops at extremely dilute concentration ranges. There is insufficient evidence to show that the data provided by applicant is sufficient to overcome the obviousness (established above) of untested mixture of compounds and/or untested crops at untested ratios and concentrations. Since the claim scope is far broader than applicant's data, applicant must provide additional evidence or arguments to establish why the limited data should be considered probative evidence of nonobviousness for the entire scope of the claimed subject matter. As nonobvious results cannot be predicted from compound to compound, in the absence of additional evidence to the contrary, applicant's evidence must be deemed insufficient.

For these reasons, all claims must be refused.

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**.

The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Gary Kunz, can be reached on **(571)272-0887**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JOHN PAK  
PRIMARY EXAMINER  
ART UNIT 1616